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09/23/2002

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 09/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/640,803

KUBO, TOSHIAKI

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to provide support for "the first layer on the first side contains a polymer latex in an amount of 50 w% or more of the total binder contained in the first outermost layer on the first side and second outermost layer on the second side contains a polymer latex in an amount of 50 wt % or more of the total binder contained in the second outermost layer on the second side. The specification as originally filed on page 2 discloses "the binder contained in the outermost layer on the same side with the image forming layer or on the opposite side of support contains a polymer latex in an amount of 59 wt % or more of the total binder. The specification as originally filed does not require polymer latex in both outermost layers. Therefore, the use of polymer latex in both outermost layers raise the issue of new matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1, 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the support for the image forming layer and the outmost layers are critical for the thermally processed image forming material.

5. Claims 1, 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language in claim 1 “(t)he binder contained in the first outermost layer on the first side and the binder contained in the second outermost layer on the second side have the common monomer composition to a degree less than 75 wt % , and the first layer on the first side contains a polymer latex in an amount of 50 w% or more of the total binder contained in the first outermost layer on the first side and the second outermost layer on the second side contains a polymer latex in an amount of 50 wt % or more of the total binder contained in the second outermost layer on the second side” is unclear in view of the claimed language per se and in view of the specification. First, the language “common monomer composition to a degree less than 75 wt %” is unclear whether the language is direct to the use of the less than 75 wt % of identical monomer in both first outermost layer and second outermost layer or otherwise. The term “degree” renders the claimed language confusing. The term “wt %” is indefinite in the absence of providing the basis of that percentage, i.e., less than 75 wt % of the binder containing in the first outermost layer and in the second outermost layer or otherwise. Second, it is

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unclear whether the "common monomer" is the monomer forming the polymer latex used in the first layer on the first side contains a polymer latex in an amount of 50 w% or more of the total binder contained in the first outermost layer on the first side and the second outermost layer on the second side contains a polymer latex in an amount of 50 wt % or more of the total binder contained in the second outermost layer on the second side" or otherwise. The specification on page 2 second paragraph discloses that language "the common monomer composition to a degree less than 75 wt %" , but fail to clearly define the term "common monomer". Thus, the scope of protection sought "common monomer" cannot be determined.

In amendment on page 6 filed on July 2, 2002, the applicants stated that "(l)n any event, the monomer composition in the binder on the same side as the image forming material has less than 75 wt % commonality with the binder on the opposite side of the support". This argument is not clear for the reason set forth above. The invention in claim 1 is related to "monomer", but not common binder used in both layer or polymer used as binder stated in claim 11 such as gelatin, polyvinyl ... and polymer latex.

Claims 3-9 are indefinite as it is unclear with respect to the antecedent basis of the term "the support".

6. The term "degree" in claim 1 is a relative term which renders the claim indefinite. The term "degree" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Note to term "degree" in the claim 1 "(t)o a degree less than 75 wt %".

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7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 3-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the thermally processed image forming material having only one side of the support coated with an image forming layer, does not reasonably provide enablement for the material having both side of the support coated with an image forming layer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to provide the invention commensurate in scope with these claims. The specification as a whole is directed to the thermally processed image forming material having only one side of the support coated with an image forming layer.

9. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claiming "(t)he binder contained in the outermost layer on the same side with the imaging layer or on the opposite side of the support contains a polymer latex in the amount of 50 w % or more of the total binder fails to further limit the invention in claim 1 which requires polymer latex of 50 wt % or more in each outermost layers.

10. The rejections over the prior art set forth in the previous office action is withdrawn in view of the amendment and applicants' argument provided on July 2, 2002.

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Conclusi n

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
September 19, 2002


Thorl Chea
Primary Examiner
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